

DISCUSSION

Upon entry of the present amendment, Claims 1-13 remain pending in the application, of which, Claims 1 and 8 are each independent. New independent claim 14 and dependent claims 15-16 are being added by the present amendment.

The above-identified Office Action has been reviewed, the references carefully considered, and the Examiner's comments carefully weighed. In view thereof, the present Amendment is submitted. It is contended that by the present amendment, all bases of rejection set forth in the Office Action have been traversed and overcome. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Restriction Requirement

In item 1 of the above-identified Office Action, the Examiner maintained the Restriction Requirement, and made it final. The Examiner has withdrawn claims 7, 8, 10, 12 and 13 as a result of the Restriction Requirement. Applicant continues to traverse the Restriction Requirement, and to request reconsideration and withdrawal thereof.

Drawing Issues

In item 5 of the above-identified Office Action, the Examiner indicated that Figures 4a and 8 of the drawings should be designated “**PRIOR ART**” because only that which is old is illustrated in those drawing Figures. Applicant has made this change as suggested, and is submitting replacement Figures 4a and 8 with the present amendment.

Claim Objections

In item 6 of the above-identified Office Action, the Examiner objected to informalities in claim 1, where he took the position that it was unclear exactly which antecedent (the vehicle or the passenger compartment) the word “thereof” was referring to.

Applicant has amended claim 1 herein, to overcome the Examiner's objection and to clarify the meaning of the claim. Applicant submits that as presently amended, all of the claims are in full compliance with the requirements of 35 USC 112, and applicant therefore requests reconsideration and withdrawal of the examiner's objection to claim 1.

Section 103 Issues

In item 8 of the above-identified Office Action, the Examiner rejected claims 1, 4-6, 9 and 11 under 35 USC 103 as unpatentable over Horiuchi et al, US 5,988,145 in view of Matsumoto et al., JP 2000-85382. The Examiner asserted that it would have been obvious to one of ordinary skill in the art, at the time of the invention, to modify Horiuchi based on the teachings of Matsumoto to provide applicant's claimed structure.

In item 9 of the above-identified Office Action, the Examiner rejected claims 1, 4-6, 9 and 11 under 35 USC 103 as unpatentable over Horiuchi et al, US 5,988,145 in view of Matsumoto et al., JP 2000-85382, and further in view of Yasuo (JP 2001-152839). The Examiner asserted that it would have been obvious to one of ordinary skill in the art, at the time of the invention, to modify Horiuchi based on the teachings of Matsumoto, supplemented by the teaching of an exhaust expansion chamber in Yasuo, to provide applicant's claimed structure.

Applicant disagrees with and traverses these grounds of rejection, and requests reconsideration and withdrawal thereof.

Neither Horiuchi Matsumoto et al. JP 2000-85382 nor any reasonable combination of these references teaches, discloses, or suggests applicant's claimed vehicle structure, in which recessed accommodating portions are formed below a vehicle passenger compartment between a fuel tank and an engine of the vehicle, in which a canister and an exhaust pipe are accommodated in respective accommodating portions below the vehicle passenger compartment, and wherein one of the respective recessed accommodating portions is located between the fuel tank and the engine.

Instead, while applicant concedes that Matsumoto teaches a recessed accommodating portion below the floor of the vehicle, the recessed accommodating portion 16 of Matsumoto is provided to receive and accommodate a fuel tank disposed below the driver and passenger's seat of the vehicle.

Moreover, applicant respectfully suggests that the Examiner is not giving proper weight to the limitations in claim 1 that the fuel tank is disposed below the rear seat, and one of the

respective recessed accommodating portions is located between the fuel tank and the engine. Applicant respectfully points out that this is directly contrary to the express teaching of Matsumoto, which explicitly specifies that the fuel tank is arranged below a driver seat, a front passenger seat, and a raised floor tunnel formed between the driver seat and the front passenger seat, in order to obtain a wider interior space in the vehicle (Matsumoto, abstract). Indeed, it is applicant's understanding that this fuel tank placement is the main focus of Matsumoto.

Applicant respectfully points out that the Express teachings of a reference cannot properly be ignored.

The Standard for Obviousness under Federal Circuit Law

Applicant respectfully wishes to call the Examiner's attention to some relevant cases of the U.S. Court of Appeals for the Federal Circuit (CAFC). The CAFC was established in 1982 to bring national standards, and a certain level of conformity and continuity to Federal patent case law. Decisions of the Federal Circuit are relevant and helpful in giving guidance to private patent practitioners, as well as to the personnel of the U.S. Patent and Trademark Office.

The U.S. Court of Appeals for the Federal Circuit has said that a reference must be viewed in its entirety, *Gore v. Garlock*, 220 U.S.P.Q. 303 (CAFC 1983) and that it is impermissible to use the claims as a frame, and the references as a mosaic, to pick and choose selected pieces, out of context, to reconstruct the invention, *Northern Telecom v. Datapoint*, 908 F.2d 931 (CAFC 1990).

The U.S. Court of Appeals for the Federal Circuit has also said that in order to combine references, the Examiner must show some motivation, suggestion, or teaching of the desirability of making the combination, *In re Dembiczak*, 50 USPQ 2d 1614, 1617 (CAFC 1999); and that the use of hindsight, in evaluating patentability, is improper, *In re Werner Kotzab*, 55 U.S.P.Q. 2d 1313 (CAFC 2000); *Gore v. Garlock*, *supra*.

Specifically, in *Kotzab*, supra, the CAFC stated:

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." *Id.*

Most, if not all inventions arise from a combination of old elements. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See *id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant (citations omitted).

Also on the standard for combining references, see MPEP section 2143.01, **Suggestion or Motivation to Modify the References.**

Applicant respectfully suggests that the Examiner may be evaluating applicant's invention using improper hindsight, picking and choosing selected portions of the references and combining those selected portions to reconstruct a mosaic of applicant's invention. Applicant respectfully suggests that such an approach is not consistent with the standards set out in the above-quoted cases of the CAFC.

Teaching Away Provides Evidence of Non-Obviousness

The Court of Appeals for the Federal Circuit has established that a prima facie case of obviousness can be rebutted if the applicant . . . can show 'that the art in any material respect taught away' from the claimed invention." *In re Geisler*, 116 F.3d 1465, 1469, 43 USPQ2d 1362, 1365 (CAFC 1997). "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, . . . would be led in a direction divergent from the path that was taken by the applicant." *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1360, 52 USPQ2d 1294, 1298 (CAFC 1999), *In re Haruna*, 249 F.3d 1327; 58 U.S.P.Q.2D 1517 (CAFC 2001).

While it is applicant's position that the Examiner has not established prima facie obviousness of any of the present claims under 35 USC §103(a), applicant also respectfully submits that Matsumoto's clear preference for placement of the fuel tank below the driver and passenger's seat *teaches away from* applicant's claimed invention, which places the fuel tank below the rear seat and the passenger compartment, and includes a recessed accommodating portion located between the fuel tank and the engine. If the entire teaching of Matsumoto is considered, it cannot be viewed as rendering applicant's claimed invention obvious, whether considered individually or in combination with other references. Since Matsumoto teaches away from applicant's claimed invention, instead of rendering applicant's claims obvious, Matsumoto actually *provides evidence of non-obviousness* of applicant's invention.

In addition to the above, Horiuchi discloses very little in the way of vehicle body structure, and fails to make up for the deficiencies of Matsumoto et al. Moreover, Yasuo also fails to make up for the deficiencies of Horiuchi and Matsumoto et al. In fact, Yasuo teaches a catalytic converter for vehicle exhaust which includes an upstream catalyst chamber 20, an intermediate chamber 30, a downstream catalyst chamber 40, and an outside air inlet means 50.

Applicant therefore requests reconsideration and withdrawal of the rejections of applicant's elected claims under 35 USC 103.

Applicant notes that minor changes have been made to claims 1 and 8 by the present amendment, to provide antecedent basis for claim elements, and to more particularly point out and distinctly claim the invention.

Applicant is also introducing new claims 14-16 by the present amendment. New claim 14 is similar to claim 1, and also specifies that the floor of the passenger compartment includes an intermediate portion disposed between the driver's seat and the front passenger seat and defining a first level, and that the recessed accommodating portions are defined by portions of the floor extending upwardly from the first level. New claims 15-16 depend from claim 14, and add limitations which are similar to those of original claims 2 and 3.

No new matter is being introduced by these new claims, since the subject matter thereof was expressly or inherently disclosed by the original specification as filed.

Applicant respectfully suggests that all of the pending claims patentably distinguish over all of the art of record.

If the Examiner feels that further issues remain to be resolved after entry of the present amendment, applicant's undersigned representative would welcome a telephone call from the Examiner to discuss such issues, and to try and resolve same.

Respectfully submitted,



Customer No. 21828
Carrier, Blackman & Associates, P.C.
24101 Novi Road, Suite 100
Novi, Michigan 48375
June 14, 2006

William Blackman
Attorney for Applicant
Registration No. 32,397
(248) 344-4422

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office on June 14, 2006.

